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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,193	09/10/2003	Deborah Ann Evrard	WYNC-0326 (AM101202NP)	5593
38791	7590	06/20/2005	EXAMINER	
WOODCOCK WASHBURN LLP ONE LIBERTY PLACE - 46TH FLOOR PHILADELPHIA, PA 19103			SHIAO, REI TSANG	
			ART UNIT	PAPER NUMBER

1626

DATE MAILED: 06/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/659,193

Applicant(s)

EVRARD ET AL.

Examiner

Robert Shiao

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on responses filed on 04/29, 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 27-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 02/23/04, 1/29/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This application claims benefit of the provisional application: 60/410,169 with a filing date 09/12/2002.
2. Amendment of claim 13 in the amendment filed on April 29, 2005, is acknowledged. Claims 1-31 are pending in the application.

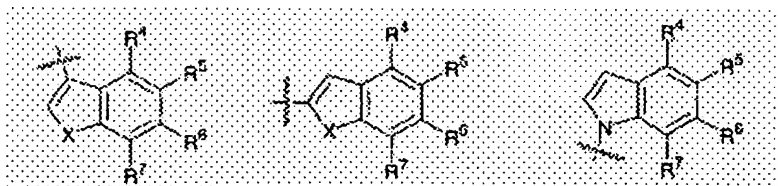
Responses to Election/Restriction

3. Applicant's election with traverse of Group I claims 1-26 and 31, in part, in the reply filed on April 29, 2005, is acknowledged. The traversal is on the grounds that examining all of the claims of Group I and V (i.e., claims 1-26 and 27-31) in a single application would not be unduly burdensome. This is found not persuasive, and the reasons are given, *infra*.

Status of the Claims

4. Claims 1-31 are pending in the application. The scope of the invention of the elected subject matter is as follows:

Claims 1-26, and 31, in part, drawn to a compound/compositions of formula (I), wherein the variable Q represents



, and the variable X

represents NR⁸ thereof; the variables p, m, R', R¹-R⁸ are as defined in claim 1.

Group I and Group V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process for using the product having indole moiety (i.e., treating depression) as claimed can be practiced with another materially different product of Macor et al. US 6,410,739.

The above mentioned withdrawn compounds which are withdrawn from consideration as being for non-elected subject matter differ materially in structure and composition from the compounds of the elected invention. The withdrawn compounds contain varying functional groups (i.e., heteroaryl or heterocycloalkyl of the variable Q) which differ from those of the elected invention such as furanyl, thiophene, etc, which are chemically recognized to differ in structure and function. This recognized chemical diversity of the functional groups can be seen by the various classification of these functional groups in the U.S. classification system, i.e., class 549 subclass 200(+) (furanyl), class 549 subclass 1(+) (thiophene), etc. Therefore, again, the compounds which are withdrawn from consideration as being for non-elected subject matter differ materially in structure and composition and have been restricted properly.

The Markush group set forth in the claims includes both independent and distinct inventions, and patentably distinct compounds (or species) within each invention. However, this application discloses and claims a plurality of patentably distinct inventions far too numerous to list individually. Moreover, each of these

inventions contains a plurality of patentably distinct compounds, also far too numerous to list individually. Moreover, the examiner must perform a commercial database search on the subject matter of each group in addition to a paper search, which is quite burdensome to the examiner.

Claims 1-26, and 31, in part, embraced in above elected subject matter, are prosecuted in the case. Claims 1-26, and 31, in part, not embraced in above elected subject matter, and claims 27-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

The requirement is still deemed proper and is therefore made **FINAL**.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating

obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

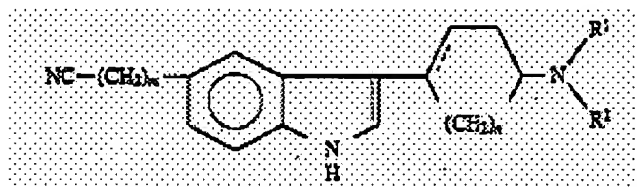
"Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Also see M.P.E.P. 2113.

6. Claims 1-26 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cipollina et al. US 5,468,767.

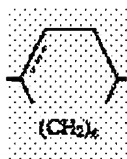
Applicants claim compounds/pharmaceutical compositions of formula (I) as agents treating depression. The instant compounds have been found on the pages 2-28 of the specification.

Determination of the scope and content of the prior art (MPEP §2141.01)

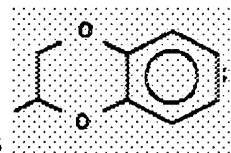
Cipollina et al. disclose a compound/compositions of formula (I) as agents treating depression,



, wherein the solid plus dotted line of the

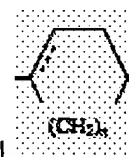


moiety represents a single or double covalent bond; the variable m is zero; the variable n represents an integer from 1 to 3; the variable R¹ represents hydrogen or



C₁₋₄ alkyl; the variable R² represents -(CH₂)_p-Ar, p is 1, and Ar is , see columns 11-12. A number of compounds have been specifically explified in column 9, Table 2.

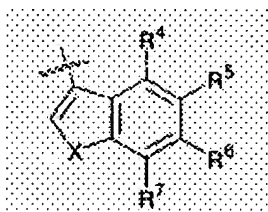
Determination of the difference between the prior art and the claims (MPEP §2141.02)



The difference between the instant claims and Cipollina et al. moiety optionally contains a double bond or a single bond, while instant compounds contain only a single bond in the same moiety.

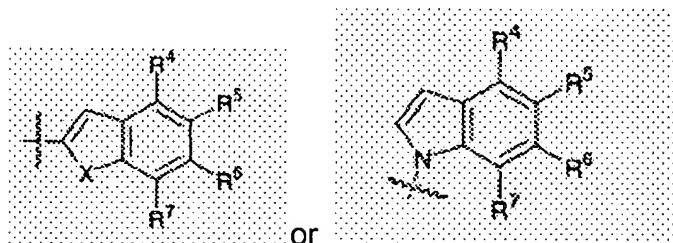
Finding of prima facie obviousness-rational and motivation (MPEP §2142-2143)

One having ordinary skill in the art would find the claims 1-26 and 31 prima facie obvious because one would be motivated to employ the compounds of Cipollina et al. to obtain instant compounds/compositions of formula (I), wherein the variable Q represents



, and the variable X represents NR⁸ thereof; the variables p, m, R', R¹-R⁸ are as defined in claim 1, i.e., variable R⁶ represents cyano, variables R', R¹, R², R⁴, R⁵, and R⁷ independently represent hydrogen; the variable p represents 0; the variable R³ represents hydrogen or alkyl.

Moreover, nothing unobvious is seen in the known Cipollina et al. structurally similar isomer for the instant claimed compounds of formula (I), wherein the variable Q represents



; the variable R⁵ represents cyano; variables R', R¹, R², R⁴, R⁶, and R⁷ independently represent hydrogen; the variable p represents 0; the variable R³ represents hydrogen or alkyl, as taught by Cipollina et al. Therefore, such structurally related compounds suggest one another and would be expected to share common properties (i.e., treating depression) absent a showing of

unexpected results, see *In re Norris*, 84 USPQ 458 (1950).

The motivation to make the claimed compounds/compositions derives from the expectation that the instant claimed compounds/compositions of formula (I) would possess similar activities, i.e., treating depression, from the known Cipollina et al. compounds/compositions to that which is claimed in the reference.

Objection

7. Claims 1-26 and 31 are objected to as containing non-elected subject matter, i.e., the variable X of formula (I) represents O or S, etc. It is suggested that applicants amend the claims to the scope of the elected subject matter as defined on the pages 2-3 *supra*.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information

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for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

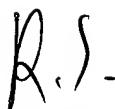
Business Center (EBC) at 866-217-9197 (toll-free).



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June 13, 2005